



Facsimile Cover Sheet

Total number of pages including cover sheet 9		Date April 15, 2003
To	Name Examiner Bui	
	Department/Company USPTO	
	Plant/Office/Address	
	Fax 703-746-4242	Telephone
From	Name Tom Derry	
	Company Caterpillar Inc., Intellectual Property Department	
	Address 100 N.E. Adams Street	
	City, State, Zip Peoria, IL 61629-6490	
	Fax (309) 675-1236	Telephone 309-675-1029

RE: Request for previous office action

Message:

As you requested I am faxing a copy of the last office action for 09/438,071 (US 6,318,551). This is related to the C.I.P. 09/960,216.

Please let me know if I can be of further assistance.

Sincerely

Tom Derry
46,660

102(b) Jackson (4,480,328)

23
→ 103(a)

22-27

085
28

DOUBLE Patterning

Confidential Communication

22-27

This message is intended only for the use of the individual or entity to which it is addressed and may contain information that is privileged or confidential. If the reader of this message is not the intended recipient or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone (collect), and return the original message to us at the above address via the U.S. Postal Service. Thank you.

APR. 15. 2003 6:44AM

INTELLECTUAL PROPERTY

NO. 1235 P. 2

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/408,071 11/10/99 CALVERT

K 99-373

LARRY R CAIN
CATERPILLAR INC
PATENT DEPARTMENT AB6490
100 N E ADAMS STREET
PEORIA IL 61629-6490

0012/0212

EXAMINER

BUI, L

ART UNIT

PAPER NUMBER

3728

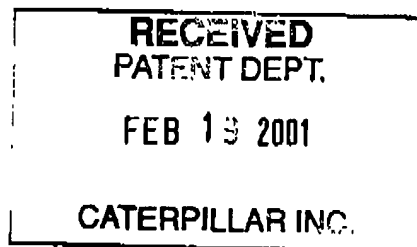
DATE MAILED:

02/12/01

DUE 5-12-01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



Office Action Summary	Application No. 09/436,071	Applicant(s) CALVERT ET AL	
	Examiner Luan K Bui	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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1. Applicant's election of Group I (claims 1-6) in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 7-20 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Vachon (4,480,368). Vachon discloses a piston assembly (10, 36) comprising a piston member (18) having a plurality of ring grooves therein, a plurality of rings (20) positioned within the ring grooves, a sleeve (12) positioned about the piston member and the rings, and an engine block/container (11) positioned about the piston member, plurality of rings and sleeve (Figures 1-2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vachon (4,480,368) in view of Official Notice and MacDonnell (3,946,873). Vachon discloses a piston assembly (10, 36) comprising a piston member (18) having a plurality of ring grooves therein, a plurality of rings (20) positioned within the ring grooves, and a sleeve (12) positioned about the piston member and the rings (Figures 1-2). To the extent that Vachon fails to show a container being positioned about the piston member, plurality of rings and sleeve, Official Notice is taken of the old and conventional practice of providing a container positioned about an article to facilitate shipping. MacDonnell, cited by way of example only, shows a package (10) for holding a piston assembly (11) comprising a container (13) positioned about the piston assembly for shipping. It would have been obvious to one having ordinary skill in the art in view of Official Notice and MacDonnell to modify the piston assembly of Vachon so it includes a container positioned about the piston member, plurality of rings and sleeve to facilitate shipping. As to claims 2-5, the container of Vachon as modified fails to show the container is a bag or the container is made from a cardboard material or plastic material. The selection of the specific material for the container such as the container is a bag or the container is made from a cardboard material or plastic material would have been an obvious matter of design choice of art recognized equivalent springs inasmuch as a number of different ones appear to be suitable and inasmuch as applicant's specification does not state that using these specific features as claimed solves any particular problem or yields any unexpected results. And, since it has been held

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to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

6. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (703) 305-5861. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148. Facsimile correspondence for this application should be sent to (703) 305-3580 for formal papers and (703) 308-7769 for draft papers.

lkb
February 7, 2001



Luan K. Bui
Primary Examiner

FORM PTO-1449 U.S. DEPARTMENT OF COMMERCE (Rev. 2-32) PATENT AND TRADEMARK OFFICE INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)	ATTY. DOCKET NO. 99-373	APPLN. NO. (Unassigned)
	APPLICANT KENNETH D. CALVERT, ET AL.	
	FILING DATE (Herewith)	GROUP

10/11 U.S. P.T.O.
09/438071
11/10/99

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	LAST NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
LKB	4,480,368	11/06/1984	Vachon			
	4,941,440	07/17/1990	Weber et al.			
	5,307,732	05/03/1994	Berlinger			
	5,765,272	06/16/1998	Borcicky			
	D 316,214	04/16/1991	O'Donnell			

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
						YES	NO

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

EXAMINER	L.K. Bai	DATE CONSIDERED	2/7/01
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EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

SHEET 1 OF 1

FORM PTO-1449 U.S. DEPARTMENT OF COMMERCE (Rev. 2-32) PATENT AND TRADEMARK OFFICE INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)	ATTY. DOCKET NO. 99-373	APPLN. NO. 09/438,071
	APPLICANT KENNETH D. CALVERT, ET AL.	
	FILING DATE November 10, 1999	GROUP

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	LAST NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE



RECEIVED
APR 28 2000
TO 3100 MAIL ROOM

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
						YES	NO

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

LKB	Bombardier Inc. Shop Manual dated 1989, 6 pages, Quebec, Canada
EXAMINER	L.K. Bui
DATE CONSIDERED	2/7/01

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Notice of References Cited

Application/Control No.

09/438,071

Applicant(s)/Patent Under
Reexamination
CALVERT ET AL.

Examiner

Luan K Bui

Art Unit

3728

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U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
	A	US-4594760-A	06-1986	Dillard	206	319
	B	US-5588525-A	12-1996	Rosler	206	319
	C	US-4722440-A	02-1988	Johnston	206	319
	D	US-4615440-A	10-1986	Downing	206	319
	E	US-3946873-A	03-1976	MacDonnell	206	592
	F	US- -				
	G	US- -				
	H	US- -				
	I	US- -				
	J	US- -				
	K	US- -				
	L	US- -				
	M	US- -				

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification	
	N	- -					
	O	- -					
	P	- -					
	Q	- -					
	R	- -					
	S	- -					
	T	- -					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.